

a request and authorization to withdraw the appropriate fee under 37 C.F.R. §§ 1.16 to 1.21 from Fulbright & Jaworski L.L.P. Deposit Account No. 50-1212/ESSR:039US/MBW.

Reconsideration of the application is respectfully requested.

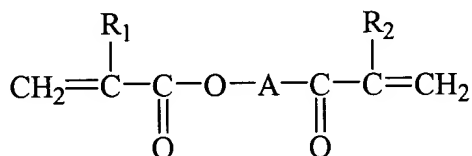
**I. AMENDMENT**

**In the claims:**

Please cancel claim 13 without prejudice or disclaimer.

Please amend claims 1, 2 and 21 as follows:

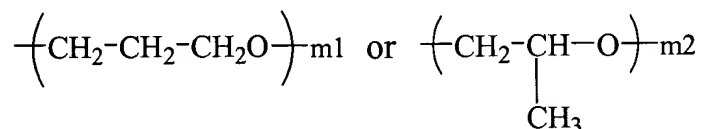
1. (Amended) A polymerized monomeric composition comprising: from 35 to 70 parts by weight of one or more monomers (I) of formula:



wherein

R<sub>1</sub> and R<sub>2</sub> represent H or CH<sub>3</sub>,

A is a divalent moiety of formula:



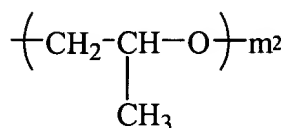
m<sub>1</sub> and m<sub>2</sub> each are an integer in the range of 4 to 20,

from 5 to 50 parts by weight of a monomer (II) comprising at least a urethane unit and at least two (meth)acrylate functions, and

from 5 to 40 parts by weight of a monomer (III) with a high Abbe number comprising at least one non aromatic cyclic or polycyclic hydrocarbon moiety and further comprising one or more methacrylate functions, the total of the monomers (I), (II), and (III) representing 100 parts by weight.

RECEIVED  
MAR 06 2003  
GROUP 1700

B1  
concl 27  
(Twice Amended) The composition of claim 1, wherein the monomer formula (I),  
said divalent A represents:



m<sub>2</sub> being defined in claim 1.

B2 20  
(Twice amended) A transparent polymer substrate with a refraction index varying  
between 1.48 and 1.52, wherein the polymer substrate is obtained through polymerization of the  
composition of claim 1.

## **II. RESPONSE TO OFFICE ACTION DATED OCTOBER 24, 2002**

### **A. Status of the Claims**

Claims 1-27 were pending at the time of the Office Action dated October 24, 2002. Claim 13 has been cancelled without prejudice or disclaimer and claims 1-2 and 21 have been amended to further clarify these claims and to put them into a more acceptable U.S. format. Support for these amendments can be found on page 11, lines 11-12 of the specification.

Accordingly, claims 1-12 and 14-27 are currently pending. A copy of the amended claims with editing indicia is attached as Appendix A. A clean copy of the presently pending claims is attached as Appendix B.

### **B. Rejection of Claim 2 Under 35 U.S.C. § 112, Second Paragraph, Is Overcome**

The Action rejects claim 2 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Action contends that claim 2 is indefinite because it recites the language "characterized in that, in."

Applicants respectfully traverse. Applicants take the position that claim 2 satisfies all requirements of 35 U.S.C. § 112, second paragraph. However, at the suggestion of the Examiner, Applicants have amended claim 2 by replacing the language “characterized in that, in” with the language “wherein” to further the prosecution of this case. In view of the fact that this amendment relates only to remedying formatting issue, it does not in any way affect the scope of the claim or range of equivalents to which the elements in the claim are entitled.

Accordingly, Applicants respectfully request that the rejection of claim 2 as being indefinite under 35 U.S.C. § 112, second paragraph, be withdrawn.

### **C. The Anticipation Rejections Are Overcome**

#### **1. Rejection of Claims 1-5, 12-13 and 16-24 under 35 U.S.C. § 102(b) is Overcome**

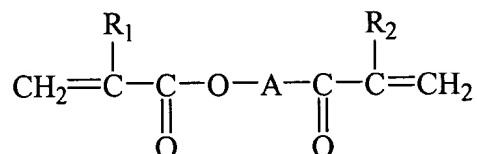
The Action rejects claims 1-5, 12-13 and 16-24 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,183,870 to Fukushima *et al* (Fukushima). The Action contends that Fukushima discloses monomers (I), (II) and (III) of present claim 1. More specifically, the Examiner states that components A, B and C of Fukushima correspond to monomers (I), (II) and (III) of the present claims.

Applicants respectfully traverse. The presently claimed invention is not anticipated by Fukushima.

Anticipation requires that each and every element of the claimed invention be described, either expressly or inherently, in a single prior art reference. *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1327, 58 U.S.P.Q.2d 1545, 1552 (Fed. Cir. 2001); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

Applicants presently claim “A polymerized monomeric composition comprising” monomers (I), (II) and (III). See Appendix B, claim 1. Applicants also claim “A transparent

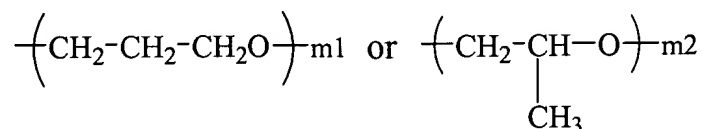
polymer substrate with a refraction index varying between 1.48 and 1.52, wherein the polymer substrate is obtained through polymerization of the composition of claim 1” (claim 21) and “An optical lens comprising a polymer substrate of claim 21” (claim 22). Monomer (I) comprises the following formula:



wherein

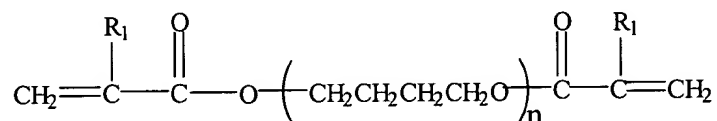
R<sub>1</sub> and R<sub>2</sub> represent H or CH<sub>3</sub>,

A is a divalent moiety of formula:



Depending on what formula is used for the A group in monomer (I), monomer (I) comprises either a *propylenoxy* group or a methylethyleneoxy group respectively.

In contrast to Applicants’ invention, Fukushima does not appear to teach or suggest the use of a monomer comprising a propylenoxy or methylethyleneoxy group. In fact, the Examiner contends that monomer A of Fukushima corresponds to monomer (I) of the present invention. The Examiner admits that monomer A of Fukushima is a poly*butylene* glycol di(meth)acrylate with the following structure:



See Fukushima, Abstract. As is evident by the above monomer in Fukushima, this monomer does not comprise either a *propylenoxy* or methylethyleneoxy group. As such, Fukushima does not appear to teach or suggest Applicants' claimed monomer (I) and does not anticipate claims 1-5, 12-13 and 16-24 of the present invention.

Accordingly, Applicants respectfully request that the rejection of claims 1-5, 12 and 16-24 under 35 U.S.C. § 102(b) as being anticipated by Fukushima be withdrawn.

## **2. Rejection of Claims 1-27 under 35 U.S.C. § 102(b) is Overcome**

The Action rejects claims 1-27 under 35 U.S.C. § 102(b) as being anticipated by EP 0 453 149 to Toh *et al.* (Toh *et al.*). The Action states that Toh *et al.* discloses a crosslinkable polymeric casting composition that is generic to the presently claimed invention. From this, the Action concludes that Toh *et al.* anticipates claims 1-27.

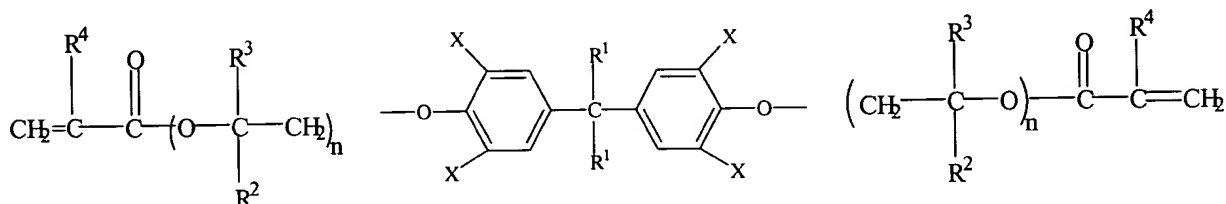
Applicants presently claim "from 5 to 40 parts by weight of a monomer (III) with a high Abbe number comprising at least one *non aromatic* cyclic or *polycyclic* hydrocarbon moiety and further comprising one or more methacrylate functions." See Appendix B, claim 1.

In contrast to Applicants' claimed invention, Toh *et al.* discloses a crosslinkable polymeric casting composition that has a (1) polyoxy alkylene glycol diacrylate or dimethacrylate; (2) monomer having a recurring unit derived from at least one radical-polymerisable bisphenol monomer capable of forming a homopolymer having a refractive index of more than 1.55; and (3) urethane monomer having 2 to 6 terminal groups selected from a group comprising acrylic and methacrylic groups. Toh *et al.*, Abstract.

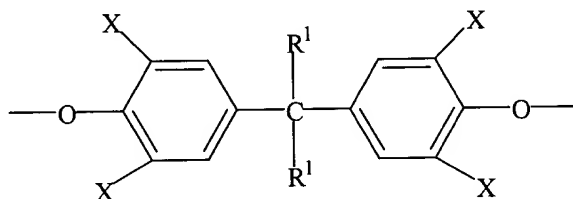
It appears that the Examiner is comparing the Toh *et al.* "monomer having a recurring unit derived from at least one radical-polymerisable bisphenol monomer capable of forming a

homopolymer having a refractive index of more than 1.55” with Applicants’ claimed monomer

III. The bisphenol monomers disclosed in Toh *et al.* have the following formulas:



It is evident from these formulas that they **do not** disclose a **non aromatic cyclic** or **polycyclic** hydrocarbon moiety. In fact, two of the bisphenol monomers in Toh *et al.* do not include cyclic structures at all. The other Toh *et al.* bisphenol monomer:



discloses an **aromatic monocyclic** bisphenol monomer.

Since Toh *et al.* does not appear to teach or suggest the use of a monomer “with a high Abbe number comprising at least one **non aromatic cyclic or polycyclic hydrocarbon moiety** and further comprising one or more methacrylate functions,” it does not teach or suggest every element of the presently claimed invention. As such, it cannot be said to anticipate Applicants’ presently pending claims.

Accordingly, Applicants respectfully request that the rejection of claims 1-12 and 14-27 under 35 U.S.C. § 102(b) as being anticipated by Toh *et al.* be withdrawn.

**D. The Obviousness Rejections are Overcome**

The Action also rejects claims 1-27 under 35 U.S.C. § 103(a) as being obvious over Toh *et al.* Again, the Action contends that Toh *et al.* discloses a crosslinkable polymeric casting composition that is generic to the presently claimed invention. From this, the Action concludes that it would have been obvious to a person of ordinary skill to make and use Applicants' presently claimed invention from the generic monomers disclosed in Toh *et al.*

Applicants respectfully traverse. Present claims 1-12 and 14-27 are not rendered obvious over Toh *et al.*

In order to establish a *prima facie* case of obviousness, three basic criteria *must* be met: (1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Manual of Patent Examining Procedure* § 2142. See also *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed Cir. 1991) (emphasizing that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, and not based on applicant's disclosure). It is important to note that all three elements must be shown to establish a *prima facie* case of obviousness. Thus, if one element is missing, a *prima facie* case of obviousness does not exist.

**1. Toh *et al.* does not teach or suggest the use of a monomer comprising at least one non aromatic cyclic or polycyclic hydrocarbon moiety**

Applicants incorporate the arguments presented in section C above. As explained in section C, Toh *et al.* does not teach or suggest the use of a monomer comprising at least one *non aromatic cyclic* or *polycyclic* hydrocarbon moiety. As such, Toh *et al.* does not teach or suggest every element of the presently claimed invention. Therefore, Toh *et al.* does not render present claims 1-12 and 14-27 obvious.

**2. There is no motivation in Toh *et al.* to modify its teachings**

There is no motivation in Toh to modify its teachings to include the use of a monomer comprising at least one *non aromatic cyclic* or *polycyclic* hydrocarbon moiety. In fact, Toh *et al.* does not even appear to mention or suggest the use of such monomers. As such, there is no motivation to modify the teachings in Toh *et al.* to include the use of Applicants' claimed invention.

Since there is no motivation to modify Toh *et al.* a second element necessary to establish a *prima facie* case of obviousness has not been met. Thus, Toh *et al.* does not render the present invention obvious.

**3. There is no reasonable expectation of success that such modifications would actually work**

There is no reasonable expectation of success that modifying the teachings of either Toh *et al.* to include the elements Applicants' claimed invention would work. Again, Toh is directed towards either *non-cyclic* or *aromatic* bisphenol monomers. In contrast, Applicants claim a monomer "with a high Abbe number comprising at least one *non aromatic* cyclic or *polycyclic* hydrocarbon moiety and further comprising one or more methacrylate functions."



Since there is no reasonable expectation of success that modifying Toh *et al.* to include Applicants' claimed monomers would work, Toh *et al.* does not render Applicants' presently claimed invention obvious.

In light of the above arguments, Applicants respectfully request that the rejection of claims 1-12 and 14--27 under 35 U.S.C. § 103(a) as being obvious over Toh *et al.* be withdrawn.

**E. Conclusion**

Applicants respectfully submit that claims 1-12 and 14-27 are in condition for allowance and respectfully request reconsideration of the application and claims in view of the above remarks. The Examiner is invited to contact the undersigned attorney at 512-536-3035 with any questions, comments or suggestions relating to the referenced patent application.

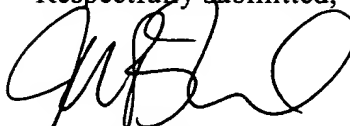
**III. PETITION FOR EXTENSION OF TIME**

Pursuant to 37 C.F.R. § 1.136(a), Applicants petition for an extension of time of one month to and including February 24, 2003, in which to respond to the Office Action dated October 24, 2002. Pursuant to 37 C.F.R. § 1.17, a check in the amount of \$110.00 is enclosed, which is the process fee for a one-month extension of time. If the check is inadvertently omitted, or should any additional fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, or should an overpayment be included herein, the Commissioner is authorized to deduct or credit said fees from or to Fulbright & Jaworski Deposit Account No. 50-1212/ESSR:039US/MBW.

FULBRIGHT & JAWORSKI L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
(512) 418-3000

Date: February 24, 2003

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mark B. Wilson', written over the typed name.

Mark B. Wilson  
Reg. No. 37,259  
Attorney for Applicants

✓